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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent of:

SHINYA MATSUI

Appln. No.: 10/736,746

Filed: December 17, 2003

For: INK-JET RECORDING APPARATUS
AND INK-JET RECORDING
PROCESS

Patent No.: US 6,890,069

Issued: May 10, 2005

Examiner: L. Tran

Group Art Unit: 2853

June 24, 2005

Mail Stop Patent Ext.

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)**

Sir:

Patentee hereby requests under 37 CFR 1.705(d) reconsideration and
recalculation of the Patent Term Adjustment (PTA) for the above-identified patent.

Submitted herewith is a check for \$200.00 for the fee set forth in 37 CFR 1.18(e). Any

deficiency in this fee may be charged or any overpayment credited to Deposit Account No.

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For the following reasons, this patent is believed to be entitled to a PTA of 84 days.

FACTS

1. The present patent issued from patent Application No. 10/736,746 (the '746 application) filed on December 17, 2003.
2. The present patent is not subject to any terminal disclaimers.
3. Throughout the period of prosecution of the '746 application, there were no circumstances as defined under 37 CFR 1.704 that would constitute a failure to engage in reasonable efforts to conclude processing or examination of the application.
4. The Patent Application Information Retrieval (PAIR) system indicates an Applicant-delay period of 120 days and a PTO-delay period of 84 days. The period of PTA assessed for the '746 application is 0 days.
5. Applicant received a Notice of Allowability along with a Notice of Allowance and Fee(s) Due dated September 15, 2004. Although Applicant had filed a Claim to Priority along with a certified copy of the Japanese priority document on May 6, 2002, in parent Application No. 10/080,677, and filed a Claim to Priority in this divisional application, neither the Notice of Allowability nor any prior communication from the PTO acknowledged receipt of the certified copy.
6. In order to gain acknowledgment of receipt of the certified copy, Applicant filed a Request for Corrected Notice of Allowability on October 7, 2004. It is presumed that the Request is listed in the PAIR system as the "Miscellaneous Incoming

Letter” dated October 7, 2004. The patent was assessed a reduction of period of adjustment of the patent term of 120 days for the first Miscellaneous Incoming Letter.

7. Applicant paid the Issue Fee on October 15, 2004.

ARGUMENTS

1. The PTO incorrectly treated the Request for Corrected Notice of Allowability as an “other paper” under 37 CFR 1.704(c)(10), and wrongly assessed 120 days of Applicant delay.

2. The Request for Corrected Notice of Allowability was necessitated due to an omission on the part of the PTO. In particular, the PTO never acknowledged receipt of the certified priority document. The Request was deemed necessary to ensure that priority was perfected.

3. As discussed in the OG Notice “Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance Has Been Mailed” dated June 26, 2001 (copy attached), only certain submissions will be considered a failure to engage in reasonable efforts to conclude processing after sending a Notice of Allowance. The Request for Corrected Notice of Allowability should be considered a submission that does not cause substantial interference and delay in the patent issue process and should not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application. Nor is such submission listed in the Notice as being among the examples of papers that are to be considered a failure to engage in reasonable efforts to conclude processing.

4. Therefore, the submission of the Request for Corrected Notice of Allowability should not cause any reduction in PTA.

RELIEF REQUESTED

Reconsideration of the patent term adjustment is respectfully requested, in which the Applicant-delay period of 120 days be removed. It is requested that the patent term adjustment be recalculated as 84 days.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark A. Williamson', is written over a horizontal line.

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Clarification of 37 CFR 1.704(c)(10) -
Reduction of Patent Term Adjustment for
Certain Types of Papers Filed
After a Notice of Allowance has been Mailed

Patent term adjustment under 35 U.S.C. 154(b)(1) is reduced by the period of time during which the applicant "failed to engage in reasonable efforts" to conclude prosecution (i.e., processing or examination of an application). See 35 U.S.C. 154(b)(2)(C)(i). Pursuant to 35 U.S.C. 154(b)(2)(C)(iii), the United States Patent and Trademark Office (Office) has prescribed regulations setting forth the circumstances constituting a failure to engage in reasonable efforts to conclude prosecution (i.e., processing or examination of an application). See 37 CFR 1.704. After a "Notice of Allowance" has been mailed, submissions by an applicant that cause a delay in processing or examination of an application will be considered a "failure to engage in reasonable efforts" to conclude prosecution. See 37 CFR 1.704(c)(10) ("failure to engage in reasonable efforts" to conclude prosecution includes submission of an amendment under 37 CFR 1.312 or other paper after a "Notice of Allowance" has been mailed). The reason such a submission is considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application is that delaying the submission of such papers until after an application is allowed causes substantial interference and delay in the patent issue process. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56373 (Sept. 18, 2000); 1239 Off. Gaz. Pat. Office 14, 19-20 (Oct. 3, 2000) (final rule).

It should be noted, however, that only certain papers (not all papers), filed after a "Notice of Allowance" is mailed, cause substantial interference and delay in the patent issue process. Therefore, it is the filing of these papers that will be considered a "failure to engage in reasonable efforts" to conclude processing and examination of an application under 37 CFR 1.704. The Office has reviewed many allowed applications (mostly continued prosecution applications (CPAs)) that were filed on or after May 29, 2000, in which the issue fee was paid. The review consistently showed that only certain papers submitted after a "Notice of Allowance" is mailed, interfered with and delayed the patent issue process to such a degree as to constitute a "failure to engage in reasonable efforts" to conclude processing or examination of an application.

Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in

reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

In contrast, the submission of other papers after a "Notice of Allowance" is mailed that do cause substantial interference and delay in the patent issue process are considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers: (1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

As guidance for minimizing reductions to any patent term adjustment, applicants should adopt practices that do not delay processing of the applications after the "Notice of Allowance" has been mailed. For instance, instead of filing corrected drawings or editorial amendments after the application has been allowed, applicant should submit such corrected drawings or editorial amendments prior to allowance of the application. In addition, instead of filing a status letter, applicant should use the private Patent Application Information Retrieval (PAIR) system to determine the status of the application (<http://pair-direct.uspto.gov>) or call the Office.

The Patent Application Locating and Monitoring (PALM) system maintains computerized contents records of all patent applications and reexaminations. PAIR is a system that provides public access to PALM for patents and applications that have been published (i.e., information for applications maintained in confidence cannot be obtained), which can be accessed over the Internet at <http://pair.uspto.gov>. The private side of PAIR at <http://pair-direct.uspto.gov> can be used by an applicant to access confidential information about his or her pending application. To access the private side of PAIR, a customer number must be associated with the correspondence address for the application, and the user of the system must have a digital certificate. For further information, contact the Customer Support Center of the Electronic Business Center at (703) 305-3028.

In addition, if PAIR is used to see the PALM records that are relied upon for patent term adjustment purposes, a contents entry with the contents code "DRWS" and the contents description "DRAWING REQUIREMENTS SATISFIED" does not indicate when the drawings were filed and is not a PALM entry that is used in the patent term adjustment calculation.

Any questions or comments about this change should be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Ms. Tyson can be reached by telephone at (703) 306-3159, or by e-mail at Karin.Tyson@uspto.gov.

May 29, 2001

NICHOLAS P. GODICI
Acting Under Secretary of
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Acting Director of the United States
Patent and Trademark Office